

panels, the plurality of panels including a number of playing game pieces; and

A9  
a removable material having a surface, wherein the removable material is disposed over the plurality of playing game pieces so as to conceal the plurality of playing game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that the plurality of unique indicia corresponds to the plurality of panels;

providing a drawing event designation, wherein the drawing event designation includes a designation of the panels to be used in game play.

## **REMARKS**

### **I. Introduction**

Claims 1-33 are pending in the present application. The Office Action of December 11, 2002 rejected claims 1-33. Please cancel claims 2 - 13 without prejudice. Claims 1, 14 and 26 have been amended and claims 34-49 have been added to clarify the subject matter recited therein and correct various informalities. Figures 5 and 6 have been added, and Figure 2 has been amended to correct various informalities. No new matter has been added. Reconsideration of the present application is respectfully requested in light of the following remarks.

### **II. Rejection of Claims 1-5, 26-28 and 31 Under 35 U.S.C. § 102(b)**

Claims 1-5, 26-28, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by Quinlan (U.S. Patent 5,671,921). It is respectfully submitted

that Quinlan does not anticipate claims 1-5, 26-28, and 31 for at least the following reasons.

Amended Claim 1 recites:

1. (Amended) A universal lottery ticket, which can be used to participate in any one of a plurality of lottery-type drawing events, the ticket comprising:

a substrate, having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the obverse side of the lottery ticket in at least one array, the at least one array including a plurality of panels, the plurality of panels including a number of playing game pieces; and

a removable material having a surface, wherein the removable material is disposed over the plurality of playing game pieces so as to conceal the plurality of game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that the plurality of unique indicia corresponds to the plurality of panels;

instructions for using the lottery ticket in conjunction with a plurality of lottery-type drawing events, wherein the instructions are disposed on the reverse side of the ticket;

a playing life of the lottery ticket.

Quinlan does not teach or suggest providing instructions for various drawing events on the reverse side of the game ticket. Nor does Quinlan teach or suggest a game ticket with the playing life of the ticket included. Therefore Quinlan does not anticipate claim 1.

Claim 2-5 have been canceled without prejudice and their rejection is now moot. However, new claims 34-38 address similar subject matter. New claim 34 recites:

34. (New) A method for playing a game of chance comprising:

receiving a game ticket, wherein the game ticket includes:

a substrate having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the obverse side in an array, the array including a plurality of panels, the plurality of panels including a number of playing game pieces; and

a removable material having a surface that is disposed over so as to conceal the plurality of playing game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that the plurality of unique indicia corresponds to the plurality of panels;

receiving a drawing event designation, wherein the drawing event designation includes a designation of the panels to be used in game play.

Quinlan does not teach or suggest a drawing event designation feature or any sort of designation of which panel to play. In Quinlan, a game participant may choose which break open window to play and open. See Col. 4:60-65. Claim 34 recites the receipt of a drawing event designation that designates which panels on the game ticket are playable. These designations may be used with the game ticket, for example, in conjunction with a broadcast TV show. Therefore a game participant will not choose which panel to remove and play. Quinlan neither teaches nor suggests this feature, and thus does not anticipate claim 34.

Claims 35-38 depend from claim 34 and should be allowable for at least the same reasons as claim 34.

Amended claim 26 recites:

26. (Amended) A lottery game, the game being played by a plurality of participants, the game comprising:

a plurality of lottery tickets, wherein each of said plurality of lottery tickets includes:

a substrate, having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the obverse side of the lottery ticket in at least one array, the at least one array including a plurality of panels, the plurality of panels including a number of playing game pieces; and

a removable material, having a surface, that is disposed over so as to conceal the plurality of playing game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that the plurality of unique indicia corresponds to the plurality of panels;

a drawing event designation;

a random selection device, wherein said random selection device selects a plurality of winning game pieces.

In support for the rejection of claim 26, the Examiner stated that Quinlan taught "a random selection device wherein the random selection device selects a plurality of winning game pieces. *See fig. 1; col 2:21-33.*" Respectfully, Applicant disagrees with the Examiner's characterization of the cited Figure 1 of Quinlan as a random selection device. The card shown in Quinlan is either a winner or a loser in a predetermined manner similar to a conventional instant-win lottery ticket. There is no drawing, randomization, or other similar device that selects winning game pieces. Quinlan does not teach or suggest a random selection device to select winning game pieces after the ticket has been

received. Quinlan provides instant win prizes on the individual play cards, so there is no selection of winning game pieces once the game participant has a play card. See Col. 3:60-65. On Quinlan's seal cards, preprinted numbers determine the advanced play contestant. See Col. 4 5-10. No winning game piece is selected in this step. Finally, the advanced play prize is awarded based on the winning amount under the break open panel. See Col. 4:62-5:1. Nowhere does Quinlan disclose a random selection device for selecting winning game pieces, therefore Quinlan cannot anticipate claim 26.

Further, as stated above, Quinlan does not teach a drawing event designation. Therefore, Quinlan does not anticipate claim 26.

Since claims 27, 28 and 31 depend from claim 26, Quinlan does not anticipate the subject matter of these claims for at least the same reasons as discussed above in connection with claim 26.

#### **IV Rejection of Claim 11 Under 35 U.S.C. § 103(a) Over Quinlan**

Claim 11 was rejected as being unpatentable under 35 U.S.C. § 103 (a) over Quinlan. Claim 11 was canceled without prejudice rendering this rejection moot. However, new claim 44 addresses similar subject matter. It is respectfully submitted that Quinlan does not render obvious claim 44 for at least the following reasons.

Claim 44 depends from claim 34, therefore claim 44 should be patentable for at least the same reasons as claim 34.

Moreover, the Examiner states that including a free space in a game is “notoriously well known in the art.” Applicant respectfully traverses this assumption. For an examiner to rely on well known prior art, the reliance must be supported by references of record. See M.P.E.P. § 2144.03. Absent a motivation to modify a reference, there is no *prima facie* case of obviousness. See M.P.E.P. § 2143.01. The Applicant respectfully submits that the number of winning combinations in Quinlan is pre-set at the time of ticket manufacture. Adding a free space to Quinlan would not increase a game player’s excitement because it is merely one of the preset winning combinations.

**V     Rejection of Claims 6-10, 14-18, 20-24, 30 and 33 Under 35 U.S.C. § 103(a) Over Quinlan in View of Kamille**

Claims 6-10, 14-18, 20-24, 30 and 33 were rejected under 35 U.S.C. § 103(a) over Quinlan in view of Kamille (U.S. Patent 5,855,514). Claims 6-10 have been canceled without prejudice making rejection moot for these claims. However, claims 39-43 address similar subject matter. It is respectfully submitted that neither Quinlan nor Kamille render obvious claims 14-18, 20-24, 30, 33 or 39-43 for at least the following reasons.

In support of the rejection of claim 14, the Examiner stated that “Quinlan teaches all of the features of the claims except said combination of playing panels comprising some but not all of the plurality of panels.” Examiner stated that Kamille taught this missing feature.

According to the M.P.E.P., the Examiner has the burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2142. Without a *prima facie* showing of obviousness, an applicant does not have an obligation to submit evidence of refuting obviousness. In order to establish a *prima facie* claim of obviousness, “all of the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03. Quinlan does not teach all of the features that the Examiner claims. Claim 14 relates to method of playing a lottery game where the game participants have a ticket and where a plurality of winning game pieces are randomly selected. As stated in the anticipation argument, Quinlan does not disclose random selection of winning game pieces after the game participant has the game ticket. Further, random selection is also not disclosed in Kamille. Kamille describes a probability game where winning is determined through the player made choices. Col. 3:59-67. Applicant respectfully submits that, since all of the limitations of claim 14 are taught by neither Quinlan nor Kamille, these references, alone or in combination, can not render claim 14 obvious.

Moreover, a *prima facie* claim of obviousness also requires some suggestion or motivation in the art to modify or combine the references. See M.P.E.P. 2143. Applicant respectfully submits that the Examiner engaged in hindsight reconstruction, which can not be used to establish obviousness. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Examiner’s stated reason – “to add the feature of revealing some but not all of the plurality of panels to control the game’s expected payout and increase player’s excitement.” Quinlan’s game

requires that all panels be opened. Revealing only some of the panels would render it inoperative.

Claims 39-43 depend from claim 34, therefore claims 39-43 should be patentable under for at least the same reasons as claim 34. Claims 15-18 and 20-24 depend from claim 14, therefore claims 15-18 and 20-24 should be patentable for at least the same reasons as claim 14. Claims 30 and 33 depend from claim 26, therefore claims 30 and 33 should be patentable for at least the same reasons as claim 26.

**VI Rejection of Dependent Claims 12, 13, 17, and 25 Under 35 U.S.C. §103(a)**

Examiner rejected claim 12 as obvious in view of Roberts (U.S. Patent No. 5,772,510). Applicant is assuming the rejection is over Quinlan in view of Roberts. Claim 12 has been canceled without prejudice so the rejection of these claims is moot. However, new claim 45 addresses similar subject matter.

As an initial matter, claim 45 depends from claim 34, therefore claim 45 should be patentable for at least the same reasons as claim 34.

Moreover, in order to establish a *prima facie* claim of obviousness, "all of the claim limitations must be taught or suggested by the prior art." M.P.E.P § 2143.03.

New claim 45 recites:

45. The method for playing a game as recited in claim 34, the method further comprising:



receiving instructions for using the game ticket in conjunction with any one of a plurality of lottery-type drawing events, wherein the instructions are disposed on the reverse side of the ticket;

providing a name of a lottery-type event on the game ticket;

providing a day of the week and time during which the lottery-type drawing event takes place;

providing an indicia of ownership and intellectual property rights of an owner or sponsor of the game;

indicating a playing life of the game ticket; and  
providing a means for authenticating the lottery ticket.

The Examiner states that Roberts discloses

(i) instructions for using the universal game ticket in conjunction with any one of a plurality of lottery-type drawing events, which instructions are disposed on the reverse side of the ticket;

(ii) providing a day of the week and time during which a lottery-type drawing event takes place;

(iii) playing life of the universal game ticket; and  
(iv) means for authenticating the lottery ticket.

Roberts does not teach all of these features. Roberts does not provide instructions on the reverse side of the ticket for using the game ticket in conjunction with a plurality of lottery type drawing events. Roberts does not teach a plurality of drawing type games, but rather describes an instant game or a single future game. Roberts makes no mention of anything on the reverse side of the ticket. At most, Roberts shows a notification of when and what time a jackpot drawing will be on the front of the ticket, for a single drawing game. See Figs. 2A-2C. Therefore Roberts does not teach or suggest instructions for using

the game ticket in conjunction with a plurality of lottery type drawing events on the reverse side of the ticket.

Further, Roberts does not teach or suggest an indication of playing life for the game ticket. Applicant respectfully submits that a single predetermined drawing time is not a playing life; in contrast a playing life allows future play at different possible times during the playing life. Roberts teaches a instant win ticket where the purchaser is instantly able to determine whether the ticket is a winner. See Col. 4:63-64. In an instant win situation there is no need for a ticket to have a playing life. Therefore Roberts does not teach or suggest an indication of playing life for the game ticket.

Even if Quinlan and Roberts taught what the Examiner argues, there is no motivation to combine the references. Absent a motivation to combine references, there is no *prima facie* case of obviousness. See M.P.E.P. § 2143.01. Applicant respectfully submits that the Examiner engaged in hindsight reconstruction, which can not be used to establish obviousness. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). A modification to modify Quinlan to include instructions for a series of drawing type of events makes no sense and undermines the fundamental principle of Quinlan's operation – Quinlan is merely an instant win game and does not have future drawings.

Claims 13 and 17 were rejected as unpatentable over Quinlan in view of Roberts in further view of Fults (U.S. Patent No. 5,788,237). Claim 13 has been canceled without prejudice so the rejection of this claim is moot. However,

new claim 46 addresses similar subject matter. It is respectfully submitted that claims 46 and 17 are patentable for at least the following reasons.

Claim 46 depends from claim 34 and claim 17 depends from claim 14, therefore claims 46 and 17 should be patentable for at least the same reasons as claims 14 and 34.

The Examiner rejected claim 25 as being obvious over Quinlan in view of Kamille in further view of Scrymgeour (U.S. Patent 6,347,794 B2). It is respectfully submitted that claim 25 is patentable for at least the following reasons.

As an initial matter, claim 25 depends from claim 14, therefore claim 25 should be patentable for at least the same reasons as claim 14.

The Examiner states that Scrymgeour discloses a "plurality of discrete gaming panels having a plurality of playing game pieces that are revealed so that the lottery ticket can be used for more than one drawing event." Scrymgeour does not teach this feature. Only one game is indicated in Scrymgeour. "The user 'plays' the lottery ticket by removing the scratch-off layer covering the lottery indicia on the front surface . . . The user then consults the lottery information printed on the ticket to determine if the lottery ticket is a winner." See Col. 4:37-45. There is no mention of a second game. Further, the game in Scrymgeour does not disclose a drawing event. Figs 6 and 7 reveal instant win lottery indicia, and not a drawing event type game. Therefore Scrymgeour cannot render claim 25 obvious.

Moreover, even if Quinlan, Roberts, and Scrymgeour taught what the Examiner suggests, there is no motivation to combine the references. Absent a motivation to combine references, there is no *prima facie* case of obviousness. See M.P.E.P. § 2143.01. Applicant respectfully submits that the Examiner engaged in hindsight reconstruction, which can not be used to establish obviousness. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The reasons for there being no motivation to combine Quinlan and Roberts were discussed above – Quinlan is basically only an instant ticket. Adding Scrygmour's features to Quinlan is similarly contrary to the operating principle of Quinlan. Quinlan has two cards, and all panels on the sealed card must be opened to choose the contestants and prizes. It would defeat the purpose of Quinlan if a separate determination were added, because all of the panels of the sealed card have already been open in the proper playing of Quinlan's game.

## **VII     Establishing Priority to U.S. Patent Application 09/794,266**

Applicants respectfully request that the Examiner acknowledge consideration statement of priority in the specification of this application. The specification states that this is a continuation in part of an application entitled ONLINE LOTTERY GAME OF CHANCE AND METHOD OF AN SYSTEM FOR PLAYING THE GAME that was filed with the United States Patent and Trademark Office on February 27, 2001 with the application number 09/794,266.

## **VIII    New Claims**

New claim 34 recites a method for playing a game which includes receiving a game ticket and receiving a drawing event designation. The drawing event designation chooses which panels are designated for game play. These features are not taught or suggested by the prior art.

New claims 35-48 depend from claim 34 and should be patentable for at least the same reasons as claim 34 as discussed above.

New claim 49 recites a method for facilitating game play which includes providing a game ticket and providing a drawing event designation.

These features are not taught or suggested in the prior art and thus these claims should be patentable over the prior art of record for at least these reasons.

## **IX Conclusion**

In view of the foregoing, it is respectfully submitted that the present claims are in condition for allowance. Passage to issuance is, therefore, respectfully requested.


Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**AMENDMENT VERSION WITH MARKING SHOWING CHANGES MADE.**"

It is therefore respectfully submitted that all of the presently pending and new claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully Submitted,

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**AMENDMENT VERSION WITH MARKING SHOWING CHANGES MADE**

1. A universal lottery ticket, which can be used to participate in any one of a plurality of lottery-type drawing events, the ticket comprising:

a substrate, having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the obverse side of the [universal] lottery ticket in at least one array, the at least one array [comprising] including a plurality of panels, [each of] the plurality of panels [comprising] including a number of playing game pieces; and

a removable material[, ] having a surface, [that] wherein the removable material is disposed over [so as to conceal] the plurality of playing game pieces so as to conceal the plurality of game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that [each of] the plurality of unique indicia corresponds to [only one of] the plurality of panels;

instructions for using the lottery ticket in conjunction with a plurality of lottery-type drawing events, wherein the instructions are disposed on the reverse side of the ticket;

a playing life of the lottery ticket.

[2. The universal lottery ticket as recited in claim 1, wherein the plurality of playing game pieces comprises a series of integers.]

[3. The universal lottery ticket as recited in claim 1, wherein the number of playing game pieces in each of the plurality of panels is at least three.]

[4. The universal lottery ticket as recited in claim 3, wherein the number of playing game pieces in each of the plurality of panels is three.]

[5. The universal lottery ticket as recited in claim 3, wherein the number of playing game pieces in each of the plurality of panels is four.]

[6. The universal lottery ticket as recited in claim 1, wherein the universal lottery ticket is played by revealing all of the plurality of playing game pieces disposed under a combination of playing panels, said combination of playing panels comprises some but not all of the plurality of panels, wherein said combination of playing panels is unique to each drawing event of the plurality of lottery-type drawing events.]

[7. The universal lottery ticket as recited in claim 6, wherein all of the plurality of playing game pieces disposed in at least three of the plurality of panels are revealed.]

[8. The universal lottery, ticket as recited in claim 7, wherein the at least three of the plurality of panels are consecutive.]



[9. The universal lottery ticket as, recited in claim 7, wherein all of the plurality of playing game pieces disposed in three of the plurality of panels are revealed.]

[10. The universal lottery ticket as recited in claim 7, wherein all of the plurality of playing game pieces disposed in four of the plurality of panels are revealed.]

[11. The universal lottery ticket as recited in claim 1, wherein one or more of the plurality of game pieces comprises a free space.]

[12. The universal lottery ticket as recited in claim 1, the lottery further comprising one or more of the following:

instructions for using the lottery ticket in conjunction with any one of a plurality of lottery-type drawing events, which instructions are disposed on the reverse side of the ticket;

a name of the lottery-type event;

a day of the week and time during which the lottery-type drawing event takes places;

indicia of ownership and intellectual property rights of the owner or sponsor of the game;

a playing life of the lottery ticket; and

a means for authenticating the lottery ticket.]

[13. The universal lottery ticket as recited in claim 12, wherein the means for authenticating the lottery ticket is selected from a group consisting of.

a concealed validation symbol that is disposed on the lottery-ticket, wherein each of the plurality of panels is associated with a unique verification symbol that is revealed along with the playing game pieces;

a coded validation symbol comprising a plurality of lines of varying thickness that can be read by a reader; wherein said coded validation symbol is unique to each lottery ticket; and  
a batch control number.]

14. A method of playing a lottery game, the game being played by a plurality of participants, each participant having at least one lottery ticket, said at least one lottery ticket comprising a plurality of concealed playing game pieces disposed in at least one array comprising a plurality of panels, the method comprising [the steps of]:

selecting some but not all of the plurality of panels as a playing panel for each game;

revealing a plurality of playing game pieces disposed on the at least one lottery ticket, wherein said plurality of playing game pieces [revealed] includes [only] those concealed playing game pieces that are disposed beneath the selected plurality of panels;

randomly selecting a plurality of winning game pieces; and

determining whether any of the at least one lottery tickets is a winning lottery ticket.

26. A lottery game, the game being played by a plurality of participants, the game comprising:

a plurality of lottery tickets, wherein each of said plurality of lottery tickets [comprises] includes:

a substrate, having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the obverse side of the [universal] lottery ticket in at least one array, the at least one array [comprising] including a plurality of panels, [each of] the plurality of panels [comprising] including a number of playing game pieces; and

a removable material, having a surface, that is disposed over so as to conceal the plurality of playing game pieces, wherein a plurality of unique indicia is disposed on the surface of the removable material so that [each of] the plurality of unique indicia corresponds to [only one of] the plurality of panels;

a drawing event designation; [ and]

a random selection device, wherein said random selection device selects a plurality of winning game pieces.

34. A method for playing a game of chance comprising:

receiving a game ticket, wherein the game ticket includes:

a substrate having an obverse and a reverse side;  
a plurality of playing game pieces, which are disposed on the  
obverse side in an array, the array including a plurality of panels, the plurality of  
panels, the plurality of panels including a number of playing game pieces; and  
a removable material having a surface that is disposed over  
so as to conceal the plurality of playing game pieces, wherein the a plurality of  
unique indicia is disposed on the surface of the removable material so that the  
plurality of unique indicia corresponds to the plurality of panels;  
receiving a drawing event designation, wherein the drawing event  
designation includes a designation of the panels to be used in game play.

35. The method for playing a game as recited in claim 34, wherein the  
plurality of playing game pieces comprises a series of integers.

36. The method for playing a game as recited in claim 34, wherein the  
number of playing game pieces in the plurality of panels is at least three.

37. The method for playing a game as recited in claim 36, wherein the  
number of playing game pieces in the plurality of panels is three.

38. The method for playing a game as recited in claim 36, wherein the  
number of playing game pieces in the plurality of panels is four.

39. The method for playing a game as recited in claim 34 further comprising:  
revealing all of the plurality of playing game pieces disposed under a  
combination of playing panels, said combination of playing panels including some  
but not all of the plurality of panels, wherein said combination of playing panels is  
unique to each drawing event of a plurality of lottery-type drawing events.

40. The method for playing a game as recited in claim 39, wherein all of the  
plurality of playing game pieces disposed in at least three of the plurality of  
panels are revealed.

41. The method for playing a game as recited in claim 41, wherein the at  
least three of the plurality of panels are consecutive.

42. The method for playing a game as, recited in claim 41, wherein all of the  
plurality of playing game pieces disposed in three of the plurality of panels are  
revealed.

43. The method for playing a game as recited in claim 41, wherein all of the  
plurality of playing game pieces disposed in four of the plurality of panels are  
revealed.

44. The method for playing a game as recited in claim 34, wherein one or  
more of the plurality of game pieces comprises a free space.

45. The method for playing a game as recited in claim 34, the method further comprising:

Receiving instructions for using the game ticket in conjunction with any one of a plurality of lottery-type drawing events, wherein the instructions are disposed on the reverse side of the ticket;

providing a name of a lottery-type event on the game ticket;

providing a day of the week and time during which the lottery-type drawing event takes place;

providing an indicia of ownership and intellectual property rights of an owner or sponsor of the game;

indicating a playing life of the game ticket; and

providing a means for authenticating the game ticket.

46. The method for playing a game as recited in claim 45, wherein providing the means for authenticating the game ticket is selected from a group consisting of:

concealing a validation symbol that is disposed on the game ticket, wherein the plurality of panels is associated with a unique verification symbol that is revealed along with the playing game pieces;

coding a validation symbol comprising a plurality of lines of varying thickness that can be read by a reader; wherein said coded validation symbol is unique to the game ticket; and

providing a batch control number.

47. The method of claim 34 further comprising:

selecting a plurality of winning game pieces.

48. The method of claim 34 further comprising:

awarding a prize based on the number of winning lines on the game ticket.

49. A method for facilitating a game of chance comprising:

providing a game ticket, wherein the game ticket includes

a substrate, having an obverse and a reverse side;

a plurality of playing game pieces, which are disposed on the  
obverse side of the lottery ticket in an array, the array including a plurality of  
panels, the plurality of panels including a number of playing game pieces; and

a removable material having a surface, wherein the removable material is  
disposed over the plurality of playing game pieces so as to conceal the plurality  
of playing game pieces, wherein a plurality of unique indicia is disposed on the  
surface of the removable material so that the plurality of unique indicia  
corresponds to the plurality of panels;

providing a drawing event designation, wherein the drawing event  
designation includes a designation of the panels to be used in game play.